REMARKS

Amendments

The claims are amended to use language in accordance with conventional US practice. These amendments do not narrow the scope of the claims. New claim 41 is directed to the elected Group. New claims 42-44 are directed to further aspects of the invention. See, e.g., page 5, lines 6-12.

Election

In response to the Restriction Requirement, applicants hereby elect Group 10, i.e., the compounds of Formula I wherein CAT^+ is polymethine and Y^- is of Formula II-2. The Office Action did not make an Election of Species Requirement. However, applicants suggest the compound of Example 20 as the starting point of the search. In any event, the Restriction Requirement is respectfully traversed.

The Restriction Requirement divides the subject matter of applicants' 40 claims into 238 Groups. Such a severe restriction of the claimed subject matter is unnecessary and unjustified. It is readily apparent that these groups are related and that the examination of related groups together will not impose an undue search burden on the Examiner.

For example, while the variable group CAT^+ is a cation selected a group of cations, these cations are all related in that they are dye cations, i.e., from azine, xanthene, polymethine, styryl, azo, tetrazolium, pyrylium, benzopyrylium, thiopyrylium, benzothiopyrylium, thiazine, oxazine, triarylmethane, diarylmethane, acridine, quinoline, isoquinoline, and quaternized azafluorenone dyes. Thus, the prior art disclosures dealing with such cations will be expected to overlap due to the common utility.

In addition, while the variable group Y^- is an anion, this anion is selected from specific genera, i.e., CAB^-, FAP^-, FAB^-, and Im^- (or Formulas II-1 to II-4). Each of these genera defines a group of anions that are clearly related in structure and thus the search require for any entity within one of these formulas will necessarily significantly overlap with the search required for any other entity encompassed by that formula.

In view of their related subject matter, it is respectfully requested that the following

Groups by examined together:

(a) all of the Groups that involve anions of Formula II-1 (i.e., Groups 1, 5, 9, 13, etc.);

(b) all of the Groups that involve anions of Formula II-2 (i.e., Groups 2, 6, 10, etc.);

(c) all of the Groups that involve anions of Formula II-3 (i.e., Groups 3, 7, 11, etc.);

(d) all of the Groups that involve anions of Formula II-4 (i.e., Groups 4, 8, 12, etc.).

Additionally, as is clear from the Restriction, the Examiner is seeking to make a Restriction within a claim. Applicants respectfully submit that 35 USC §121 does not permit restriction within a single claim as clearly indicated by the court in *In re Weber et al.*, 198 USPQ 328 (1978).

> As a general proposition, an applicant has a right to have *each* claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the right of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits.
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> It is apparent that §121 provides the Commissioner with the authority to promulgate rules designed to *restrict* an *application* to one of several claimed inventions when those inventions are found to be "independent and distinct." It does not, however, provide a basis for an examiner acting under the authority of the Commissioner to *reject* a particular claim on that same basis. [*Weber* at 331-332]

The effect of restriction within a single claim is the same as a rejection. 35 USC §121 does not give the Commissioner authority to require that a single claim "be divided up and presented in several applications" and thus deny the Applicant the right to have that single claim considered on its merits. This is exactly the action that the Court in *Weber* stated was not permitted under 35 USC §121. Such action by an Examiner would violate "the basic right of the Applicant to claim his invention as he chooses." [*Weber* at 332]. Thus, withdrawal of the Restriction is respectfully requested.

As for the method of use claims, if the Restriction is maintained as to these claims, applicants will request rejoinder pursuant to MPEP 821.04.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,
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